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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,103	09/10/2004	Yoel Sasson	SASSON=3	2096
1444 7590 05/04/2010 BROWDY AND NEIMARK, P.L.L.C. 624 NINTH STREET, NW SUITE 300 WASHINGTON, DC 20001-5303				
EXAMINER				
PURDY, KYLE A				
ART UNIT		PAPER NUMBER		
1611				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/507,103

Applicant(s)

SASSON ET AL.

Examiner

Kyle Purdy

Art Unit

1611

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 3-13, 15-17, 20-22, 24, 25 and 28-31 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 3-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17, 20-22, 24, 25 and 28-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 5 pages (01/27/2010; 02/26/2010)
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of Application

1. The Examiner acknowledges receipt of the amendments filed on 1/26/2010 wherein claims 15, 22 and 28 have been amended and claims 29-31 are newly added.

2. Claims 15-17, 20-22, 24, 25 and 28-31 are presented for examination on the merits. The following rejections are made.

Response to Applicants' Arguments

3. Applicants arguments filed 1/26/2010 regarding the rejection of claims 15, 16, 20, 22 and 28 made by the Examiner under 35 USC 103(a) over Taranta et al. (US 2002/0098221) in view of Aven (US 6165940) have been fully considered but they are not found persuasive.

4. Applicants arguments filed 1/26/2010 regarding the rejection of claims 17, 21, 24 and 25 made by the Examiner under 35 USC 103(a) over Taranta et al. (US 2002/0098221) in view of Aven (US 6165940), in further view of Lubetzky et al. (EP 6070113) have been fully considered but they are not found persuasive.

5. The rejection of claims 15-17, 20-22, 24, 25 and 28 made by the examiner under 35 USC 103(a) is **MAINTAINED** for the reasons of record in the office action mailed on 7/27/2009.

6. In regards to the 103(a) rejection, Applicant asserts the following:

A) The disclosure of Tanaka regarding the use of a solvent is not 'limited', as suggested by the Examiner;

B) The Board has previously said that absent a reason/motivation for selecting from a 'basket' disclosure, no proper basis can be made for such a rejection. Applicant asserts this is currently the case; and

C) Tanaka requires a polar co-solvent to prevent crystallization, thus Tanaka teaches away.

7. In response to A, Tanaka requires picking one or more solvents from the group of esters of aliphatic monocarboxylic acids, esters of aliphatic dicarboxylic acids, esters of aromatic monocarboxylic acids esters of aromatic dicarboxylic acids and tri-n-alkylphosphates. If an ordinary person wanted to make a formulation wherein the solvent comprised an ester of aliphatic monocarboxylic acids, then selecting a species from *that* group would be 'limited'. Because Tanaka compartmentalizes each solvent genera, any person, upon choosing their generic solvent, could have readily arrived at Applicants instantly claimed solvent species, i.e. lactate ester. Reading a list and selecting a known compound to meet known requirements, i.e. solvating ability, is no more ingenious than selecting the last piece in the last opening in a jigsaw puzzle. See MPEP 2144.07. Moreover, MPEP 2141(III) says that choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success is grounds for a *prima facie* case of obviousness.

8. In response to B, the Examiner respectfully disagrees that selection of a lactate ester from Tanaka is absent motivation or reason. Lactate esters are taught to be a solvent useful for solubilizing fungicides. What other motivation is Applicant looking for? Upon deciding to use an ester of an aliphatic monocarboxylic acid, picking and choosing solvents from that generic group would have been obvious. And if one were to find that lactate esters were particularly useful over others, then that finding would have been one of ordinary skill and common sense, not one of innovation.

9. In response to C, the Examiner does not dispute this. However, this does not mitigate the current rejection, nor does it teach away. Applicants claims do not exclude the addition of co-

solvents. So this disclosure is within the scope of Applicants claims. Additionally, it is the position of the Examiner that prevention of crystallization is a benefit of including lactate esters into the fungicidal composition. The fact that Applicant has discovered a property for an otherwise known composition does not provide a contribution over the prior art because while that property may have not been known or recognized, that property has always been present. The discovery of an unappreciated property does not impart patentable weight to claimed subject matter. Mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. *In re Wiseman*, 596 F.2d 1019, 201 USPQ 658 (CCPA 1979).

Maintained Rejections, of Record
Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

12. Claims 15, 16, 20, 22 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taranta et al. (US 2002/0098221; of record) in view of Aven (US 6165940; of record).

13. Taranta is directed to oil-in-water (EW) formulations of insecticides for agricultural purposes. The composition is taught to also comprise one or more solvents including carboxylic acids with functional groups such as lactic acid (see [0032]; see instant claim 15). Exemplified compounds are ethylhexyl lactate, butyl lactate, ethyl lactate and so on (see [0032]; see instant claim 16). The formulation is to comprise from between 1 to 25% by weight of a co-solvent such that crystallization of the product is inhibited (see [0045]; see instant claim 20). Taranta teaches also teaches that the pesticide is to be included in the composition from 0.05 g/L to 200 g/L (0.005% to 20% by weight).

14. Taranta fails to specifically teach a composition that comprises a lactate ester. Taranta fails to teach the composition as having a weight ratio between the pesticide and the lactate ester as being from 1:1 to 1:4. Taranta also fails to teach the EW as comprising any of the instantly claimed pesticides

15. Aven is directed to non-aqueous suspension concentrates for agricultural purposes. It is taught that the concentrate can be formulated into aqueous dispersions and emulsions (column 8, lines 21-25). Exemplified pesticides for crop protection include flusilazole, prochloraz and penconazole (see column 3, lines 5-25).

16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Taranta and Aven with a reasonable expectation for success in arriving at a pesticidal composition comprising a lactate ester wherein the pesticide is

perchloraz, flusilazole or penconazole. As taught by Taranta, lactate esters are useful for solvating pesticidal agents. With respect to the requirement that the weight ratio of the pesticide to lactate ester this limitation is obvious. One ordinarily skilled in the art would be motivated to adjust the ratio of the compounds knowing that one is needed to kill the desired pest and that the other is needed to prevent premature crystallization of the composition. If by standard optimization of the composition one found that a ratio of 1:1 to 1:4 was useful and significant, then this result would be one of ordinary skill and common sense, and not one of innovation. With respect to including perchloraz, one would have been motivated to include such pesticides because they are known to be useful for protecting agricultural crops from insect damage. Therefore, a pesticidal EW comprising a lactate ester wherein the pesticide and the lactate ester have a weight ratio of 1:1 to 1:4 is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

17. Claims 17, 21 and 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taranta et al. (US 2002/0098221; of record) in view of Aven (US 6165940; of record) as applied to claims 15, 16, 20, 22 and 28 above, and further in view of Lubetzky et al. (US 0670113; of record).

18. v

19. Taranta fails to teach the EW compositions as comprising a rosin component.

20. Lubetzky cures this deficiency. Lubetzky is directed to agrochemical EWs. The EW comprises a pesticide and a rosin/rosin derivative (see abstract). Exemplified rosin derivatives

include rosin esters (see page 4; see instant claim 17). It is taught that inclusion of rosin and rosin derivatives are beneficial because they impart stability to the composition as well as reduce phytotoxicity (see page 4). The plasticizer is to be included into the composition at a weight percent of from about 0.5% to about 50% (see page 2; see instant claims 21 and 24). Pesticides are to be included into the composition from about 4.5% to about 67% by weight (see page 2).

21. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Taranta and Aven with Lubetzky with a reasonable expectation for success in arriving at an EW comprising a rosin derivative from 1 to 15% by weight of the composition. One would have been motivated to include rosin derivatives into the EW of Taranta because in doing so would result in a product with enhanced stability and reduced phytotoxicity. With respect to the requirement that the weight ratio between the pesticide and the rosin be from 1:0.05 to 1:1, this requirement is obvious. As the compositions are directed to pesticidal EWs, and rosin derivatives are being included to impart stability and reduce phytotoxicity, one ordinarily skilled in the art would endeavor to optimize a composition such that the effects of both were strongly utilized. If such a result were that the weight ratio between the pesticide and the rosin was 1:0.05 to 1:1, then this result would be one of ordinary skill and common sense. Therefore, a pesticidal EW comprising a rosin derivative wherein the pesticide and the rosin have a weight ratio of 1:0.05 to 1:1 to is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

24. **Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Taranta et al. (US 2002/0098221; of record) in view of Aven (US 6165940; of record).**

25. Taranta and Aven are discussed above in detail.

26. Taranta teaches that the solvent can be used in an amount up to 30% by weight (see Table 1). Taranta also teaches that the active substance can be present in an amount up to 20% (see [0028]).

27. Taranta fails to include any of the exemplified fungicides.

28. Aven is directed to non-aqueous suspension concentrates for agricultural purposes. It is taught that the concentrate can be formulated into aqueous dispersions and emulsions (column 8, lines 21-25). Exemplified pesticides for crop protection include flusilazole, prochloraz and penconazole (see column 3, lines 5-25). Aven teaches that these compounds can be used up to 40% by weight (see abstract).

29. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teachings of Taranta and Aven with a reasonable expectation for success in arriving at a pesticidal composition comprising a lactate ester used in amount of 30% by weight and a fungicides such as perchloraz, flusilazole or penconazole in an amount of 20% (or 40%). As taught by Taranta, lactate esters are useful for solvating pesticidal agents. Although Taranta fails to specifically teach an amount of lactate ester for use in the compositions, Taranta does teach generally via Examples that the solvent can comprise up to 30%. Thus, any person would have been motivated to use any of their listed solvents at those values taught useful for other similar solvents. With respect to the amount of fungicides, this is also obvious. Both Taranta and Aven teach providing fungicides in amounts within the instantly claimed range. Aven teaches perchloraz as a functional equivalent to the pesticides taught by Taranta. So with respect to including perchloraz in to the composition of Taranta, one would have been motivated to include such a fungicide because it was known to be useful for protecting agricultural crops from damage like those taught by Taranta. Therefore, the instantly claimed invention is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

30. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Taranta et al. (US 2002/0098221; of record) in view of Aven (US 6165940; of record) as applied to claim 29 above, and further in view of Lubetzky et al. (EP 0670113; of record).

31. Taranta and Aven are relied upon for disclosure described in the rejection of claim 29 under 35 U.S.C. 103(a).

32. Taranta and Aven fail to includes a rosin in an amount from 1-10% by weight.

33. Lubetzky cures this deficiency. Lubetzky is directed to agrochemical EWs. The EW comprises a pesticide and a rosin/rosin derivative, which acts as a plasticizer (see abstract). Exemplified rosin derivatives include rosin esters (see page 4). It is taught that inclusion of rosin and rosin derivatives are beneficial because they impart stability to the composition as well as reduce phytotoxicity (see page 4). The plasticizer is to be included into the composition at a weight percent of from about 0.5% to about 50% (see page 2).

34. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Taranta and Aven with Lubetzky with a reasonable expectation for success in arriving at an EW comprising a rosin derivative from 1 to 10% by weight of the composition. One would have been motivated to include rosin derivatives into the EW of Taranta because in doing so would result in a product with enhanced stability and reduced phytotoxicity. In cases where the claimed ranges 'overlap or lie inside ranges disclosed by the prior art' a *prima facie* case of obviousness exists. See MPEP 2144.05. Therefore, a pesticidal EW comprising a rosin derivative in an amount of 1-10% by weight is *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in absence of evidence to the contrary.

Conclusion

35. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

36. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

37. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle A. Purdy whose telephone number is 571-270-3504. The examiner can normally be reached from 9AM to 5PM.

38. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharmila Landau, can be reached on 571-272-0614. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

39. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*/Kyle Purdy/
Examiner, Art Unit 1611
May 3, 2010*

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/David J Blanchard/
Primary Examiner, Art Unit 1643